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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/997,159	11/28/2001	Edwin Jay Sarver	2255.003	3616

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EXAMINER

BARRETT, THOMAS C

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 09/02/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application N .

09/997,159

Applicant(s)

SARVER, EDWIN JAY

Examiner

Thomas C. Barrett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4,5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

## **DETAILED ACTION**

### ***Specification***

The amendment filed October 3, 2002 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "Hearn D. and Baker, M.P., Computer Graphics, Second Edition, Prentice Hall, Inc. (1994),"

Applicant is required to cancel the new matter in the reply to this Office Action.

The disclosure is objected to because of the following informalities: The applicant misspelled a word "spectaeie" in line 18 of page 5 and there is an incomplete sentence in line 9 page 12 (As would be known to those skilled in the art...)

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, it is unclear whether the applicant is claiming a procedure for correcting vision or a method of determining the optimal surgical method. It is indefinite whether the "said procedure" of step "g" refers to the "initial procedure recommendation

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in step "e" or the procedure of correcting vision in the preamble. If it refers to the procedure of the preamble, no steps are claimed for the actual procedure performed.

In addition, it is indefinite which "eye" is being referred to in step b; the "eye of a patient" in the preamble or the eye of step "a".

Claim 1 also recites the limitation "said method" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Regarding claims 5 and 6, the word "means" is preceded by the word(s) "ray transfer element" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).

Please Note: Issues under § 112, sixth paragraph exist. If Applicant wishes 35 U.S.C. § 112, sixth paragraph, interpretation, Applicant must:

Show why the claim language properly invokes 35 U.S.C. § 112, sixth paragraph,

Identify the function,

Identify the corresponding structure.

It is further suggested that the specification be amended to explicitly state what structure corresponds to the claimed terms and phrases, provided no new matter is introduced.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 4-5 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Rajan et al. (5,891,131). Rajan et al. discloses a procedure for correcting vision in an eye caused by defects in the cornea (Fig. 2) comprising: inputting categorical and continuous data for an eye (32 and 34), examining the patient's eye and building a model (34 and 35), compare the model with the data (37), compare a predicted outcome to determine acceptability (4) and perform the acceptable procedure (col. 2, lines 52-56). The steps can be iterated until a predicted outcome is acceptable (41), and the outcome viewed on a display (Fig. 1, 14A).

Furthermore, the data is converted into aberrations (col. 3, lines 25-60 and figs. 3-6). Due to the indefiniteness of claims 5 and 6, this feature reads over the "means" limitation as best can be interpreted by the examiner.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rajan et al. (5,891,131) as above in view of Herekar et al. (6,149,643). Rajan et al. discloses a procedure for correcting vision in an eye caused by defects in the cornea however Rajan et al. fails to disclose inputting and updating data from the patient's eye including method and outcome. Herekar et al. teaches inputting and updating data from the patient's eye including method and outcome (col. 3, lines 39-48), which is useful to an attending physician to design a course of treatment for future patients (col. 13, lines 1-12). It would have been obvious to one of ordinary skill in the art to combine the teaching of inputting and updating data from the patient's eye including method and outcome, as taught by Herekar et al., to a procedure for correcting vision in an eye as per Rajan et al., in order to assist an attending physician in designing a course of treatment for future patients.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas C. Barrett whose telephone number is (703) 308-8295. The examiner can normally be reached Tuesday-Friday between 9:00 A.M. and 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (703) 308-2111. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3580 for regular communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308 0850.

A handwritten signature in black ink, appearing to read 'Thomas Barrett', with a stylized flourish at the end.

Thomas Barrett  
August 25, 2003